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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,961	08/15/2001	Frank Duvinage	10537/154	2156
26646	7590	11/19/2004		
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004				
			EXAMINER TRAN, HIEN THI	
			ART UNIT 1764	PAPER NUMBER

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/929,961

Applicant(s)

DUVINAGE ET AL.

Examiner

Hien Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/15/01&8/23/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I, claims 1-5, in the reply filed on 10/19/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 6-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/19/04.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "7" has been used to designate both the inlet-side section (page 5, lines 27-28) and the particle filter coating (page 6, line 30). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

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by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the drawings to comply with CFR 1.84(p)(5), e.g. they should include the reference sign(s) mentioned in the specification and vice versa.

### *Specification*

6. The disclosure is objected to because of the following informalities:

On page 5, line 12 --or lambda probe-- should be inserted before "S4" for consistency (note page 10, line 7).

Appropriate correction is required.

7. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 835,684.

EP 835,684 discloses an exhaust gas cleaning unit for diesel engine of a motor vehicle comprising: a particle filter; and a nitrogen oxide store being disposed upstream of the particle filter; the filter including a coating of noble metal or three-way catalyst, such as platinum (col. 1, lines 3-7; col. 2, lines 3-12, 32-40, 44-49, etc.).

Instant claims 1-4 structurally read on the apparatus of EP 835,684.

10. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Blanchard et al (FR 2,780,096-corresponding to US 6,767,526).

Blanchard et al discloses an exhaust gas cleaning unit for diesel engine of a motor vehicle comprising: a particle filter; and a nitrogen oxide store being disposed upstream of the particle filter (col. 2, lines 57-60; col. 4, lines 54-67; col. 5, lines 28-67 in US 6,767,526).

Instant claims 1-2 structurally read on the apparatus of Blanchard et al.

11. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Bruggemann et al (2002/0033017).

Bruggemann et al discloses an exhaust gas cleaning unit for diesel engine of a motor vehicle comprising: a particle filter 12; and a nitrogen oxide store 20 being disposed upstream of the particle filter.

Instant claims 1-2 structurally read on the apparatus of Bruggemann et al.

12. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoffmann et al (2001/0052232).

Hoffmann et al discloses an exhaust gas cleaning unit for diesel engine of a motor vehicle comprising: a particle filter 4; a nitrogen oxide store 3 being disposed upstream of the particle filter; an oxidation catalyst 12 being disposed between the nitrogen oxide store 3 and the particle

filter; lambda probes and wherein the filter being coated with particulate ignition coating (see, for example, sections 0002, 0032, 0050; 0057; 0058; Figs. 1-5).

Instant claims 1-5 structurally read on the apparatus of Hoffmann et al.

13. Claims 1-2 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/885,626 which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

Application No. 09/885,626 discloses an exhaust gas cleaning unit for diesel engine of a motor vehicle comprising: a particle filter 12; and a nitrogen oxide store 20 being disposed upstream of the particle filter.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

#### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 835,684 in view of Hoffmann et al (2001/0052232).

The apparatus of EP 835,684 is substantially the same as that of the instant claim, but fails to disclose provision of a lambda probe.

However, Hoffmann et al discloses the conventionality of providing lambda probes in controlling the purification system (sections 0048-0053).

It would have been obvious to one having ordinary skill in the art to use the lambda probe in controlling the purification system of EP 835,684 as taught by Hoffmann et al, as use of such is conventional in the art and no cause for patentability here.

17. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Bruggemann et al (2002/0033017) in view of Hoffmann et al (2001/0052232).

The apparatus of Bruggemann et al is substantially the same as that of the instant claims, but is silent as to provision of an oxidation catalyst and a coating on the filter and a lambda probe.

The same teachings of Hoffmann et al apply.

It would have been obvious to one having ordinary skill in the art to provide a lambda probe, an oxidation catalyst and a coating on the filter in the apparatus of Bruggemann et al, so as to enhance the purification of the exhaust gas thereof as taught by Hoffmann et al.

18. Claims 3-5 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 09/885,626 which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

The apparatus of copending Application No. 09/885,626 is substantially the same as that of the instant claims, but is silent as to provision of an oxidation catalyst and a coating on the filter and a lambda probe.

The same comments with respect to Hoffmann et al apply.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).



***Double Patenting***

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1-2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 13 of copending Application No. 09/885,626. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same conceptual invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

21. Claims 3-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 13 of copending Application No. 09/885,626 in view of Hoffmann et al (2001/0052232).

The apparatus of copending Application No. 09/885,626 is substantially the same as that of the instant claims, but is silent as to provision of an oxidation catalyst and a coating on the filter and a lambda probe.

The same comments with respect to Hoffmann et al apply.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is (571) 272-1454. The examiner can normally be reached on Tuesday-Friday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Hien Tran*

HT  
November 17, 2004

**Hien Tran**  
**Primary Examiner**  
**Art Unit 1764**